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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,477	05/17/2001	Akira Sekine	H6810.0021/P021	2982

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L STREET NW  
WASHINGTON, DC 20037-1526

EXAMINER
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GAKH, YELENA G

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/858,477

Applicant(s)

SEKINE ET AL.

Examiner

Yelena G. Gakh, Ph.D.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 19-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Election filed 10/21/03 is acknowledged. In response to the Applicant's arguments regarding restriction requirements the examiner reassigns claims 39-40 to Group I. As to the essence of the restriction requirements, Group II drawn to a computerized system is classified in class 379, which is beyond examiner's expertise. The system basically comprises several hardware parts and a set of databases, which should be examined differently from the method claims. Therefore the restriction requirements are valid and are made FINAL.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 12, 39 and 40 recite "analyzing a preset amount of said materials in said process", which is an unclear expression; it is not apparent, what "analyzing" means here, and why the amount of the materials should be analyzed, if it is "preset", i.e. known.

It is further not clear from the claims the way they are written, which substances belong to the same group and therefore are assigned the same control number. Are these controlled substances involved in the same process? Are they chemically similar compounds? The language of the claims renders them unclear and indefinite.

Claims 2, 8 and 14 are not clear. What is meant by a definition "a specified compound"? Is this the same as a "controlled compound"? Aren't controlled compounds specified?

Claim 39 is not clear. The second step recited in the claim is very confusing. How is it possible for a substance not to be legally controlled but to belong "to one of said legally controlled substances"? The whole expression should be clarified, since it is incomprehensible both grammatically and technically.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-8 and 39-40** are rejected under 35 U.S.C. 102(b) as being anticipated by Sturgeon et al. (US 5,664,112).

Sturgeon teaches a method of integrated Hazardous Materials Management (HMM), providing database for materials containing hazardous compounds and grouping controlled (hazardous) substances by Hazardous Materials Index. "The HMM grouping 21 monitors consumption of chemicals and chemical mixtures, using process definitions and using manual drawdown for non-process consumption. Process definitions cover all chemicals used as input materials for a given process. Process templates provide users with reusable process definitions and with process run parameters such as process run date and frequency of use. Chemical emissions, outfalls and by-product wastes are tracked as they arise by the HPM [Hazardous Permit Management] and HWM [Hazardous Waste Management] groupings 31 and 51. The HMM grouping 21 can generate in-house chemical transfer and usage reports and mass balance reports" (col. 12, lines 21-31). Process templates intrinsically provide ratio of discharge and emission quantity of hazardous compounds. HMM includes handling precautions, hazards and legal regulations with the databases provided by an outsourcing company (Figures 1-2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.

Yelena G. Gakh  
1/13/04

A handwritten signature in cursive script, appearing to read "Yelena Gakh", written in black ink.